

## **REMARKS**

### **I. Double Patenting Rejections**

Claims 2, 6, 8-15, and 35 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over various claims in U.S. Patent No. 6,533,720. In response to this rejection, Applicant submits herewith the appropriate terminal disclaimer and fee. In view of these submissions, Applicant respectfully submits that the obviousness-type double patenting rejections have been overcome.

### **II. 35 U.S.C. § 102(b) Rejections**

Independent Claims 8, 15, and 35 and various dependent claims were rejected under 35 U.S.C. § 102(b) as being anticipated either by U.S. Patent No. 4,567,880 to Goodman or U.S. Patent No. 5,201,908 to Jones. Because neither Goodman nor Jones teaches each and every element in the claims, Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of these claims be withdrawn.

#### **A. Rejections Based on Goodman**

As shown in Figure 1 of Goodman, the endoscopic device 10 in Goodman is made up of three separate components: a sheath 12, a valve-bridge assembly 16, and a telescope portion 14. It is important to note that the valve-bridge assembly 16, which is asserted to correspond to Applicant's recited endoscope valve assembly, is an integral part of the endoscopic device 10. That is, without the presence of the valve-bridge assembly 16, the sheath 12 and telescope portion 14 could not join together to form a workable endoscopic device 10. Specifically, the mechanical components on the proximal end of the sheath 12 are specifically designed to fit with the valve-bridge assembly 16 and not the telescope portion 14. That is, the sheath 12 comprises a coupling piece 30 that has a locking ring 34 with a pair of inwardly-facing alignment notches 36

that are specifically designed to mate with pins 52 on the valve-bridge assembly 16. After the pins 52 on the valve-bridge assembly 16 are inserted into the notches 36 on the coupling piece 30 of the sheath 12, the locking ring 34 can be rotated to lock the valve-bridge assembly 16 onto the sheath 12. The telescope portion 14 does not contain similar pins, but rather contains a “key hole”-shaped protrusion that mates with a “key hole”-shaped aperture in the valve-bridge assembly 16. Because the coupling piece 30 of the sheath 12 and the telescope portion 14 have incompatible mechanical parts, the sheath 12 and telescope portion 14 are not designed to be joined together without the valve-bridge assembly 16. Accordingly, the valve-bridge assembly 16 is an essential and integral part of the endoscopic device 10 in Goodman. That is, the valve-bridge assembly 16 in Goodman serves not only as a valve but also as a necessary mechanical “bridge” between the sheath 12 and telescope portion 14.

In contrast, an endoscope valve assembly of a preferred embodiment is designed to be used as an “add-on” component to an existing endoscope rather than an integral component of an endoscope, as in Goodman. The independent claims recite elements that are directed to this “add-on” feature. Specifically, independent Claim 8 recites a housing and a mounting surface that comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. There is absolutely no disclosure in Goodman of a mounting surface that comprises a surface of a mounting pad comprising a resilient material and that is separately formed from a housing. Significantly, the Office Action did not assert a specific component in Goodman that purportedly teaches this feature — the Office Action merely made a general reference to several paragraphs in Goodman. To repeat, there is absolutely no disclosure in Goodman (either in the cited paragraphs or elsewhere) of a mounting surface that comprises a

surface of a mounting pad comprising a resilient material and that is separately formed from a housing.

As an additional ground of patentability, independent Claims 8, 15, and 35 also recite that the mounting surface is shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes. As discussed above, the valve-bridge assembly 16 in Goodman has a very unique shape, with one end being specifically designed to mechanically couple with a certain-shaped coupling piece 30 of a sheath 12 and the other end being specifically designed to mechanically couple with a different-shaped telescope portion 14. Accordingly, because the valve-bridge assembly 16 is designed to fit only a single-shaped sheath coupling piece 30 and a single-shaped telescope portion 14, the valve-bridge assembly 16 does not have a mounting surface shaped to allow the valve-bridge assembly 16 to fit on medical endoscopes with different shapes. Further, because the valve-bridge assembly 16 in Goodman is an integral part of the endoscopic device 10, the valve-bridge assembly 16 in Goodman does not “*fit on*” a medical endoscope, as recited in independent Claims 8, 15, and 35. Instead, the valve-bridge assembly 16 is *part of* the medical endoscope. That is, because the sheath 12 and the telescope portion 14 cannot be used together to make an endoscope without the valve-bridge assembly 16, the sheath 12 and telescope portion 14 by themselves do not make an endoscope upon which the valve-bridge assembly 16 can “fit on.”

In conclusion, because Goodman does not teach each and every element of independent Claims 8, 15, and 35, the 35 U.S.C. § 102(b) rejections of those claims and their dependent claims should be withdrawn.

**B. Rejections Based on Jones**

Independent Claims 8, 15, and 35 each recite elements not shown in Jones. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of those claims and their dependent claims be withdrawn.

As a first matter, independent Claim 8 recites a housing and a mounting surface that comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. There is absolutely no disclosure in Jones of a mounting surface that comprises a surface of a mounting pad comprising a resilient material and that is separately formed from a housing. Significantly, the Office Action did not even mention this element in the rejection of the claim, let alone explain which feature in Jones purportedly corresponds to this element. For this reason alone, the rejection of independent Claim 8 and its dependent claims should be removed.

As an additional ground of patentability, independent Claims 8, 15, and 35 also recite a mounting surface that is shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes. This feature is not shown in Jones. As shown in Figure 9 of Jones, the removable attachment 102 that carries the valve system 116 has a trapezoidal-like shape that exactly matches the trapezoidal-like shape of the endoscope 100. In this way, the removable attachment 102 fits onto the endoscope 100 in a mating fashion. Because of the unique shape of the removable attachment 102, the valve system 116 and attachment can only fit on endoscopes with the same shape as the endoscope 100 shown in Figure 9. If an endoscope of a different shape were used, the different shape would not mate with the shape of the removable attachment 102. Accordingly, Jones does not teach a mounting surface that is shaped to allow

the endoscope valve assembly to fit on medical endoscopes with different shapes, as recited in independent Claims 8, 15, and 35.

As yet another ground of patentability, independent Claims 8, 15, and 35 each recite an outlet port configured to be releasably connected to an irrigation port of a medical endoscope. This feature is not shown in Jones. Jones describes a sheath for protecting an endoscope from contamination. To allow an endoscope to be used multiple times without sterilization, a protective sheath is placed over the endoscope to prevent contamination of the exterior surface of the endoscope. The endoscope in Jones does not have an irrigation port. Accordingly, Jones teaches that channels of the protective sheath are used instead of the irrigation port of a medical endoscope. (Even if an endoscope with an irrigation port were used, the valve assembly would be connected to the channels of the protective sheath instead of to the irrigation port of the endoscope. Otherwise, water, air, or suction supplied by the irrigation port would be blocked by the closed end portion of the protective sheath.)

As shown in Figure 9 of Jones, the outlet port of the valve assembly is connected to the channels of the disposable protective sheath placed over the endoscope. Accordingly, the outlet port of the valve assembly in Jones is not connected to the irrigation port of the endoscope, and one skilled in the art would not have been motivated to further modify Jones to connect the outlet port of the valve assembly to the irrigation port of the endoscope because Jones teaches away from such a modification. Jones specifically states that “[i]t is an important feature of the present invention that access channels 60 extend alongside the endoscope’s flexible portion 16 ***rather than through the endoscope*** as in many prior art instruments.” Col. 5, lines 47-51 (emphasis added). Jones further states that connecting the outlet port of a valve assembly to an irrigation

port of an endoscope would contaminate the endoscope and “fundamentally differs from the present invention.” Col. 1, lines 60-63.

In conclusion, because Jones does not teach each and every element of independent Claims 8, 15, and 35, the 35 U.S.C. § 102(b) rejections of those claims and their dependent claims should be withdrawn.

### **III. 35 U.S.C. § 103 Rejections**

Independent Claims 2, 6, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of Goodman and U.S. Patent No. 6,221,007 to Green. Because the proposed combination of Goodman and Green does not teach each and every one of the claim elements and because there is no motivation to combine Goodman and Green, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejections be withdrawn.

As a first matter, Applicant notes that the basis of this rejection is that Goodman teaches (1) a mounting surface that comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing and (2) a mounting surface shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes. As discussed above with respect to the 35 U.S.C. § 102(b) rejections based on Goodman, Goodman does not disclose these features. There is absolutely no disclosure in Goodman of a mounting surface that comprises a surface of a mounting pad comprising a resilient material and that is separately formed from a housing, and the valve-bridge assembly 16 in Goodman is not shaped to fit on medical endoscopes with different shapes, as the valve-bridge assembly 16 has a very unique shape that is specifically designed to mechanically couple with only-certain shaped components. Further, because the valve-bridge assembly 16 in Goodman is an integral part of the endoscopic device 10, the valve-bridge assembly 16 in Goodman does not “*fit on*” a medical endoscope, as

recited in independent Claims 2, 6, and 12. Accordingly, even if Goodman were combined with Green, the proposed combination would fail to teach each and every element in the claims.

Further, Applicant respectfully submits that one skilled in the art would not have been motivated to combine Goodman with Green. In the Office Action, it was asserted that it would have been obvious to secure the valve assembly in Goodman to an endoscope using a strap. Applicant respectfully disagrees. As discussed above, the valve-bridge assembly 16 in Goodman serves not only as a valve but also as a necessary mechanical “bridge” between the sheath 12 and telescope portion 14. Without the mechanical connection provided by the valve-bridge assembly 16, the sheath 12 and telescope portion 14 could not join together to form a workable endoscopic device 10. Accordingly, using a strap to join the valve-bridge assembly 16 to the sheath 12 or telescope portion 14 would render the endoscopic device 10 in Goodman inoperable. As such, one skilled in the art would not have been motivated to make the proposed combination.

For at least the reasons discussed above, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejections of independent Claims 2, 6, and 12 and their dependent claims be withdrawn.

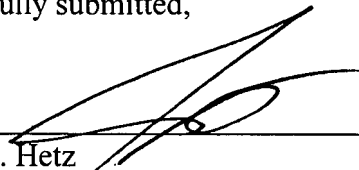
#### **IV. Conclusion**

In view of the foregoing remarks, Applicant respectfully submits that this application is in condition for allowance. Reconsideration is respectfully submitted. It should be noted that while only some elements of the independent claims were discussed above, other elements of the independent claims, as well as the dependent claims, provide additional grounds of patentability. Applicant reserves the right to present these additional grounds at a later time, if necessary.

If there are any questions concerning this Response, the Examiner is invited to contact the undersigned attorney at (312) 321-4719.

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Respectfully submitted,



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